Interview Summary Okay -- /E.D./ 04/27/2008

REMARKS

Claims 1-5 and 7-26 are pending. Claims 1, 2, 14, 15, 17 and 22 have been amended. Support is found throughout the specification. See, for example, paragraphs [0006], [0244] and Examples 1 and 2 of US Pub. No. US 2004/0043430 A1. No new matter is introduced by way of this amendment.

Interview Summary

Applicants kindly thank the Examiner for the courtesy of a telephonic interview on January 22, 2008. Applicants discussed the rejections of record, technical problems with the January 4, 2008 Response to the Office Action of October 5, 2007, and support for the amendments in the January 4, 2008 Response. Agreement was not reached.

Claim Rejection under 35 USC §§ 101 and 112

Claims 1-5 and 7-26 are rejected under 35 USC §§ 101 and 112 as failing to provide a utility. The Office Action suggested that the claims lacked patentable utility because the "claims do not recite any particular improvement or resultant characteristic that is imparted to proteins generated by the instant method or how analysis of the resultant secondary protein sequences would be used to yield any useful information." While Applicants respectfully disagree, it is noted that the claims have been amended in an effort to further prosecution of this application. Applicants submit that the claims recite a method that results in the generation of a secondary library of amino acid sequences that are selected based on at least one desired characteristic relative to a target protein. The claimed method results in synthesizing and screening of a variant protein for the at least one desired characteristic. Thus, the claimed methods do set forth an improvement and an indication of how the analysis of the secondary protein sequences would be used to yield useful information. Accordingly, Applicants respectfully submit that the claims are patentable. Applicants respectfully request the Examiner to withdraw the rejections under 35 USC §§ 101 and 112.

Written Description Requirement under 35 USC § 112, first paragraph

In response to a question raised during the telephonic interview, Applicants respectfully submit that the amendment of "screening for said at least one desired characteristic" fully complies with the written description requirement. As stated in the MPEP, § 2106 (V)(B)(1):

> For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67, 43 USPQ2d 1398, 1404-05 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998). The claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. Software aspects of inventions, for example, may be described functionally. *See Robotic Vision Sys. v. View*